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REMARKS

Claims 1-30 were pending in the application as examined, although claims 18-21 were withdrawn as being directed to a non-elected invention. In the Final Office Action, claims 1-30 were rejected under 35 U.S.C. § 112; claims 1-16 and 23-29 were rejected under 35 U.S.C. § 102(a) as being anticipated by Blackwell *et al.* and/or by Clemons *et al.*; claims 23-29 were rejected under 35 U.S.C. § 103(a) as being obvious over either of the same two references. The Final Office Action indicated that claims 17 and 22 were allowable.

1. Amendments to the Claims

Claims 1, 2, 23 and 26-30 have been amended. Claims 9, 10, 18-21 and 24-25 are cancelled. Claims 3-8 and 11-22 remain unchanged. Applicant respectfully submits that no new matter is added through the proposed amendment to the claims. The proposed amendments are fully supported by the specification and claims, as originally filed.

Specifically, claims 1 and 2 have been amended to couch the claims around the elected group (i.e., R₃ is an aryl moiety having the specific structures defined in now cancelled claim 10). This amendment finds specific support for example in original claim 10 (which is now cancelled). Claims 1 and 2 have also been amended to correct a discrepancy between variables R₅, R₆ and R₇ as depicted in the structures and as defined in the claims. In addition, claims 1 and 2, as amended, recite a "pharmaceutically acceptable salt, ester, or salt of such ester." This language finds specific support, for example, in paragraph [0017] on page 6 of the specification, as filed.

Claims 23 and 26-29 have been amended to comport with "library" claim language allowed by the USPTO. See discussion re: 112 rejection below.

Finally, the dependency of claim 30 has been amended in view of the cancellation of claims 10 and 18-21.

No new matter is being introduced by these amendments.

2. Rejection of claims 1-30 under 35 U.S.C. § 112

Claims 1 and 2 are rejected as being indefinite for having inconsistent descriptions of variables R₅ and R₇. The amendments to claims 1 and 2 render this rejection moot.

Claims 23-25 were rejected for failure to limit the scope of the independent claims from which they depend. Claims 24 and 25 are now cancelled. Thus the rejection is moot with respect to these claims.

Applicant is at loss with respect to the Examiner's statement that claim 23, drawn to a library of compounds of claim 1 or 2, is improper. Applicant respectfully points out that numerous United States Patents have issued with claims to compounds and claims to libraries of these compounds in the same patent. For example, Applicant points to the following 8 exemplary issued United States Patents that claim compounds and libraries of these compounds:

US 7,053,214	US 7,008,941	US 6,943,167	US 6,943,157
US 6,413,963	US 6,013,458	US 5,929,237	US 5,786,448

Claims 23 and 26-29 have been amended to comport with "library" claim language allowed by the USPTO. Support for this language can be found throughout the specification, as filed (See for example, pages 40-45 of the specification). In view of the USPTO's history of allowing this type of claims, Applicant respectfully submits that claims 23 and 26-29 are allowable.

In light of Applicant's remarks above, withdrawal of the rejection under §112 of record is earnestly requested.

3. Rejections under 35 U.S.C. § 102(a) and 103(a)

Both of the cited art references were published less than a year prior to the filing of the provisional application to which the present application claims priority, and therefore are cited under 35 USC § 102(a).

Claims 1-16 and 23-29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Blackwell *et al.* "Decoding Products of Diversity Pathways from Stock Solutions Derived from Single Polymeric Macrobeads", *Angew. Chem. Int. Ed.* 40(18):3421-3425, 2001 (hereinafter, "Blackwell").

Claims 1-14 and 23-30 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Clemons *et al.* "A one-bead, one-stock solution approach to chemical genetics: part 2", *Chem. Biol.* 8:1183-1195, 2001 (hereinafter, "Clemons").

Claims 23-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Blackwell *et al.*

Applicant submits herewith a declaration under 37 C.F.R. § 1.131 from inventor Robert A. Stavenger describing the conception and reduction to practice of the claimed invention on a date before September 14, 2001, the date Blackwell first became available to the public, which is also before Clemons first became available to the public.

In order for a reference to qualify as prior art under 35 U.S.C. § 102(a)/103(a), it must be known or used both by another, or described in a printed publication . . . *prior to the invention* by the applicant. Even if either the Blackwell *et al.* or the Clemons *et al.* reference could be said to describe (in accordance with the requirements of the patent statutes) one or more of the claimed compounds and/or libraries, such description cannot be prior to the claimed invention by Stuart L. Schreiber, Robert A. Stavenger, Timothy J. Mitchison, and Zoltan Maliga, the named inventors on the instant application, and all rejections based on them should be removed.

4. Objection to the Drawing

The Examiner has objected to Figures 23-25 because the legends are hand-written. Applicant is hereby submitted replacement figures with printed legends.

CONCLUSION

In light of the foregoing, Applicant submits that the claims, as currently amended, are in condition for allowance. A notification to that effect is respectfully requested.

In the interests of advancing this case towards allowance, Applicant explicitly authorizes the Examiner to further amend the claims should the Examiner deem it necessary to place the case in condition for allowance.

If a telephone conversation would help clarify any issues, or help expedite prosecution of this case, Applicant invites the Examiner to contact the undersigned at (617) 248-5150.

It is not believed that fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that any additional fees required for consideration of this paper (including fees for net addition of claims) are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully Submitted,
CHOATE, HALL & STEWART LLP



Nadège M. Lagneau, Ph.D.
Registration No. 51,908

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PATENT DEPARTMENT
CHOATE, HALL & STEWART LLP
Two International Place
Boston, MA 02110
Telephone: (617) 248-5000
Facsimile: (617) 248-4000